

Remarks

The Applicants note with appreciation the Examiner's helpful reminder with respect to the Abstract. The Applicants have accordingly amended the Abstract so that it is in a single paragraph and contains other minor editorial changes. Entry into the official file is respectfully requested.

The Applicants also note with appreciation the Examiner's helpful comments with respect to the claims as previously written that may be interpreted differently from what is meant. The Applicants have accordingly amended Claims 1, 2, 3 and 1.7 to clarify the various components of the claimed films. At a minimum, each claim now recites a composition comprising a) a poly(lactic acid) polymer, and b) a plasticizer having a polyether segment. Various other features are presented in the four different independent claims. Entry of these changes into the official file is also respectfully requested.

Claims 1-9, 11 and 13-17 stand rejected under 35 U.S.C. §102 or §103 over US '332 or US '857. The Applicants again note with appreciation the Examiner's detailed comments hypothetically applying those publications against the rejected claims. The Applicants respectfully submit, however, that neither publication anticipates the claimed subject matter and neither publication renders the claims obvious. Concise reasons are set forth below.

The rejection with respect to US '332 is fundamentally based on the position that it discloses a plasticizer that has at least one poly(lactic acid) segment having a molecular weight of 1200 or more per molecule and comprises a polyether and/or polyester segment. The Applicants respectfully submit that US '332, while it does disclose a plasticizer having a polyester segment, does not disclose a plasticizer having a polyether segment. The Applicants have carefully scrutinized the entire US '332 disclosure and find no reference to a plasticizer having a polyether segment. The

importance of this is reflected by the fact that the Applicants affirmatively claim in each of their independent claims a plasticizer having a polyether segment.

The Applicants wish to point out the fact that the disclosure of polyester segments is not the same as the Applicants' claimed polyether segments. Those skilled in the art know that there are serious differences between polyesters and polyethers. They are not the same and have completely different characteristics. Thus, the disclosure of polyesters by US '332 can in no way be deemed as an equivalent of or similar to a disclosure of polyether segments.

The Applicants respectfully submit that the rejection under §102 requires that every claimed component of the Applicants' films be disclosed by US '332. The Applicants respectfully submit that US '332 does not disclose a plasticizer having a polyether segment. Accordingly, the Applicants respectfully submit that US '332 cannot be applied under §102.

As to the rejection based on §103, the Applicants respectfully submit that US '332 is non-enabling since there is no disclosure concerning polyethers, much less polyether segments associated with a plasticizer. One skilled in the art is not provided with a disclosure that is enabling or would allow for some modification of that disclosure to result in the claimed plasticizer with a polyether segment. As such, the Applicants respectfully submit that US '332 is inapplicable under §103 as well. Withdrawal of the dual rejection under §102 and §103 based on US '332 is respectfully requested.

The Applicants respectfully submit that US '857 is also inapplicable under §102 and §103. In that regard, the Applicants agree that US '857 discloses a plasticizer. However, it does not disclose the Applicants' plasticizer that has poly(lactic acid) segments and polyether segments. Similarly, US '857 discloses a polymer of a poly(lactic acid). But again, US '857 does not disclose

the polymer having poly(lactic acid) segments and polyether segments. Therefore, US '857 is completely different from and inapplicable to the Applicants' claims 1-9, 11, 13-15, 16 and 17.

The Applicants also respectfully submit that US '857 fails to have any appreciation for the Applicants' discovery that the excellent flexibility of the Applicants' films is imparted to the poly(lactic acid) by using the plasticizer as claimed. This particular claimed combination also prevents high levels of evaporation, migration and extraction, i.e., bleed out. Thus, the Applicants respectfully submit that the claimed subject matter provides unexpected results that are not disclosed or suggested by US '857. Withdrawal of the rejection is respectfully requested.

Claims 15 and 16 stand rejected under 35 U.S.C. §103 over US '332. The Applicants respectfully submit that they have already established that US '332 is inapplicable to Claims 1, 9, 11 and 13-17. The Applicants respectfully submit that US '332 is inapplicable to Claims 15 and 16 for exactly the same reasons. Withdrawal of that rejection is respectfully requested.

Claims 1-9, 11, 13-15, 16 and 17 stand rejected under 35 U.S.C. §103 over EP '894 or JP '665. The Applicants note with appreciation the Examiner's helpful comments with respect to the hypothetical application of those publications against the claims. The Applicants nonetheless respectfully submit that both of EP '984 and JP '665 are inapplicable. Reasons are set forth below.

The plasticizer disclosed by EP '894 is not the same as what the Applicants' specifically claim. EP '894 discloses plasticizers including aliphatic polybasic acid ester, aliphatic polyhydric alcohol ester and oxyacid ester. A number of examples of those three basic groups are provided in the EP '894 disclosure.

However, there is no disclosure concerning a plasticizer that has polyether segments. Polyethers are not the same as aliphatic polybasic acid esters, aliphatic polyhydric alcohol esters and oxyacid esters. As noted above, esters or polyesters are completely different from polyethers which

is what the Applicants claim. Therefore, EP '894 is non-enabling with respect to disclosures concerning the Applicants' claimed polyether segments. Therefore, the Applicants respectfully request that EP '894 is inapplicable. Withdrawal of that portion of the rejection is respectfully requested.

The Applicants note the rejection of Claims 1-9, 11 and 13-17 under 35 U.S.C. §103 as being over JP '665. The Applicants respectfully submit that JP '665 fails to disclose or suggest every aspect of those rejected claims. For example, JP '665 fails to disclose a film that has a tensile modulus of elasticity of 100 to 1500 MPa. The reason for this is quite simple. JP '665 merely mentions films and only in the context of a fiber that consists of a constituent that may be a film. There is no discussion of the film or its characteristics. On this basis alone, the Applicants respectfully submit that all of Claims 1-9, 11 and 13-17 clearly distinguish over JP '665.

The Applicants also respectfully submit that JP '665 fails to provide disclosure sufficient to support a rejection of those claims based on an inherency of the film having a tensile modulus of elasticity of 100 to 1500 MPa. As noted above, the disclosure of JP '665 is completely devoid of any disclosure other than the mere existence of a film. There is no disclosure about any characteristic of any film that could theoretically be formed from any JP '665 composition.

In any event, the Applicants respectfully submit that inherency rejections may only be supported if the disclosure upon which the rejection is based contains sufficient relevant disclosure that the claimed physical characteristic that is inherently present is "necessarily" present. It is not good enough that the claimed physical characteristic might be present, could be present, might possibly be present or even likely to be present. An inherency rejection must be based on physical characteristics that are "necessarily" present.

The Applicants respectfully submit that such disclosure does not exist in this case. The Applicants have already provided an example of one manner in which the claimed films can be formed. There is no such disclosure in JP '665 that would leave one skilled in the art with any reasonable expectation that a film hypothetically formed based on the JP '665 disclosure would have the claimed tensile modulus. The only example in JP '665 is for the production of yarns formed from fibers of the composition. Thus, it can be seen that, at a minimum, the steps subsequent to forming chips in the JP '665 examples are completely different from the steps typically utilized by the Applicants in forming their films. Those steps would introduce any number of possible variables into the materials formed by those steps and one skilled in the art would have a very reasonable expectation that the physical characteristics of the fibers/yarns produced by JP '665 would have very different physical characteristics compared to the films produced by the Applicants. Thus, one skilled in the art would have a reasonable expectation that the tensile modulus of JP '665 would be completely different from the tensile modulus claimed by the Applicants. Of course, this is all taken in the context of the fact that the only example provided by JP '665 is directed to formation of yarn, whereas the Applicants specifically claim a film. The Applicants, therefore, respectfully submit that JP '665 is completely inapplicable to Claims 1-9, 11 and 13-17 and respectfully request that JP '665 be withdrawn.

In light of the foregoing, the Applicants respectfully submit that the entire Application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,



T. Daniel Christenbury
Reg. No. 31,750
Attorney for Applicants

TDC/as
(215) 656-3381